

AMENDMENTS TO THE DRAWINGS

Appendix A attached hereto includes an annotated sheet of newly added Fig. 5 which illustrates an exemplary method of the present invention as claimed in claim 16. A new sheet of Fig. 5 is also attached in Appendix A.

Attachment: Annotated Drawing Sheet
New Sheet

REMARKS

The Official Action dated June 20, 2005, has been carefully considered. Accordingly, the changes and remarks presented herewith are believed sufficient to place the present invention in condition for allowance. Reconsideration is respectfully requested.

The specification has been amended in accordance with the objections set forth by the Examiner in the present Official Action. Proposed drawing corrections have also been submitted, as indicated in Appendix A, with respect to Fig. 5 to address objections set forth by the Examiner. Claim 13 has been amended for a minor informality and claims 17-20 have been added. Support for the newly added claims may be found in the specification at pages 6-9. Since this amendment does not involve any introduction of new matter, entry is believed to be in order and is respectfully requested.

Claim 16 was rejected by the Examiner under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner asserted that the specification inadequately describes the method steps as stated by claim 16. Furthermore, the Examiner asserted that the claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicants respectfully traverse this rejection, the assertions made by the Examiner, and requests reconsideration.

In view of the Examiner's comments, Applicants have amended the specification by providing information explaining the method described in claim 16. Furthermore, a drawing has been provided to illustrate the method described in claim 16. It is believed that these changes do not involve any introduction of new matter and are supported by the specification of the current application. In addition, on page 3 beginning at line 28, the specification states, "[y]et another embodiment of the present invention is a method for receiving, through a cellular network system, a facsimile on a printer, wherein the printer lacks facsimile receiving

functionality. The method comprises: receiving facsimile data in a first format from a cellular network system; decoding the received facsimile data in a first format from a cellular network system; decoding the received facsimile data into a second format; generating print data corresponding to the received facsimile data in the second format; and transmitting the print data to a printer to record an image corresponding to the print data.” In light of the amendments to the specification, Applicants believe claim 16 is in a condition for allowance and respectfully request that the Examiner reconsider the rejection under 35 U.S.C. §112, first paragraph.

Rejection under 35 U.S.C. § 103(a)

Claims 1-16 were rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Ishida et al (U.S. Patent 5,041,918) in view of Frazier et al (U.S. Patent 6,349,135). The Examiner asserted that Ishida discloses all subject matter in the current application. The Examiner conceded that Ishida fails to teach or disclose a “cell” radio. The Examiner asserted Frazier teaches the use of a cell radio in an adapter for the purpose of allowing for mobile facsimile machines. Therefore, the Examiner asserted it would have been obvious for one of ordinary skill in the art at the time the claimed invention was made to incorporate the use of Frazier’s cell radio, for the purpose of allowing for mobile facsimile machine, in the adapter of Ishida in order to receive facsimiles in plural and mobile places.

However, as will be set forth in detail below, it is submitted that the adapters and systems set forth by presently amended claims 1-20 are non-obvious over and patentably distinguishable from Ishida et al. in view of Frazier et al. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

As defined by claim 1, the present invention is directed to an adapter for connecting a printer to a cellular radio system, wherein the adapter enables the printer to conduct facsimile operations, comprising: a facsimile module, wherein the facsimile module includes

executable instructions for decoding fax data and processing the fax data to generate print data for printing; a cell radio; one or more communication ports, wherein at least one of the communication ports is in communication with the printer; and a data encoder in communication with the facsimile module and the cell radio, wherein the data encoder is configured to convert data transmitted between the facsimile module and the cell radio.

Ishida discloses an adapter unit which comprises an interface means connected to the host apparatus for receiving document information therefrom; bit map conversion means supplied with the document information from the interfaces means for converting teletex data and mixed mode data contained in the supplied document information into bitmap data; facsimile encoding means for converting the bitmap data into facsimile image information; facsimile decoding means for converting facsimile image information into bitmap data; print interface means connected to the host apparatus for outputting print control data to the host apparatus for printing the bitmap data; communication network for sending and receiving document information to and from the network; and system control means for controlling the interface means, the bitmap conversion means, the facsimile encoding means, the facsimile decoding means, the print control means and the communication control means. The deficiencies of Ishida are not overcome with the combination of Frazier. Ishida, alone or in combination with Frazier, does not teach or suggest **a wireless facsimile adapter containing a data encoder in communication with a facsimile module and cell radio, wherein the data encoder is configured to convert data transmitted between a facsimile module and cell radio.**

Frazier discloses a method for transmitting a digital message from a source to one or more receiving devices, and a method for transmitting a digital message from a source to one or more receiving destinations (Col. 1, lines 52-53; lines 62-64). Additionally, Frazier discloses a method wherein after the digital message is received from the source, the digital

message is routed through a wide area network, if necessary, until each of the one or more receiving destinations are accessible by a local area network (Col. 2, lines 6-10).

As noted above, the present invention is directed to an adapter for connecting a printer to a cellular radio system, comprising *inter alia*, **a data encoder in communication with the facsimile module and the cell radio, wherein the data encoder is configured to convert data transmitted between the facsimile module and the cell radio.** The facsimile adapter unit of Ishida and the method and system for a wireless digital message of Frazier fail to teach such capabilities as set forth by the present claims. Frazier does not disclose a data encoder in communication with the facsimile module and the cell radio, wherein the data encoder is configured to convert data transmitted between the facsimile module and the cell radio. Figures 3A-C of Frazier describe devices utilizing modems to convert data to transmit outgoing facsimile messages over a telephone line via PSTN interface and through a personal computer. See Col. 5, lines 35-38; Col. 5, lines 53-57; Col. 6, lines 5-15. However, neither the drawings nor the specification detail **a data encoder in communication with the facsimile module and the cell radio that converts data transmitted between the facsimile module and the cell radio.**

To establish prima facie obviousness of the claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981; 180 U.S.P.Q. 580 (CCPA 1974). Moreover, in order for references to be relied upon to support a rejection under 35 U.S.C. § 103 they must provide an enabling disclosure, i.e., they must place the claimed invention in the possession of the public. *Glaxo Inc. v. Novopharm Ltd.*, 34 U.S.P.Q.2d, 1565 (Fed. Cir. 1995); *In re Payne*, 203 U.S.P.Q. 245 (CCPA 1979). Applicants find no teaching or suggestion by Ishida and Frazier, alone or in combination, to teach, disclose or suggest an adapter for connecting a printer to a cellular radio system comprising,

inter alia, a data encoder in communication with the facsimile module and the cell radio that converts data transmitted between the facsimile module and the cell radio.

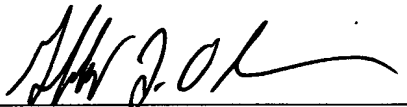
In view of the failure of Ishida and Frazier, alone or in combination, to teach or suggest an adapter for connecting a printer to a cellular radio system, wherein the adapter enables the printer to conduct facsimile operations, comprising: a facsimile module, wherein the facsimile module includes executable instructions for decoding fax data and processing the fax data to generate print data for printing; a cell radio; one or more communication ports, wherein at least one of the communication ports is in communication with the printer; **and a data encoder in communication with the facsimile module and the cell radio, wherein the data encoder is configured to convert data transmitted between the facsimile module and the cell radio**, the combination of Ishida and Frazier do not support a rejection of claims 1-16 under 35 U.S.C. § 103(a). Applicants submit that claims 1-16 would not have been obvious with respect to Ishida in view of Frazier and respectfully request that the Examiner withdraw his rejection of claims 1-16.



CONCLUSION

For the above reasons, applicants respectfully submit that claims 1-20 recite allowable subject matter. The Examiner is encouraged to contact the undersigned to resolve efficiently any formal matters or to discuss any aspects of the application or of this response. Otherwise, early notification of the allowance of all claims in the application is respectfully solicited.

Respectfully submitted,

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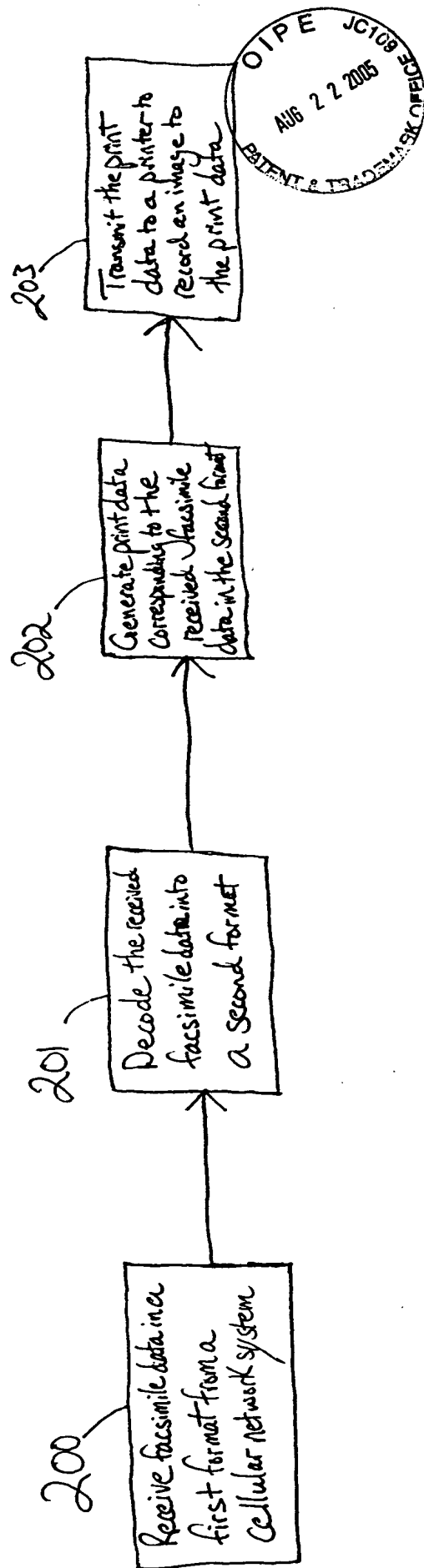


Fig. 5